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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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HENLEY III, RAYMOND J

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/031,922	<b>Applicant(s)</b> GAYED, ATEF	
	<b>Examiner</b> Raymond J. Henley III	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,16,29,31-34 and 37-53 is/are rejected.
- 7) ☒ Claim(s) 3-15,17-28,30,35 and 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**CLAIMS 1-7 AND 10-53 ARE PRESENTED FOR EXAMINATION**

Applicant's After-final Amendment filed January 20, 2004 and Supplemental Information Disclosure Statement filed December 15, 2003 have been received and entered into the application. Accordingly, claims 33, 45, 48, and 51 have been amended. Also, as reflected by the attached, completed copy of form PTO-1449 (2 pages), the cited references have been considered.

The indicated allowability of the claims listed in the previous Office action is **withdrawn** in view of the newly discovered considerations which are explained below. Also, the finality of that action is **withdrawn**.

Such considerations came to light to the Examiner subsequent to the Telephone Interview with Applicant's representative (note attached Interview Summary Record). The Examiner regrets any inconvenience this may cause.

***Claim Rejection - 35 USC § 103***

Claims 1, 2, 16, 29, 31-34, 37-44 and 45-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergamini et al., (U.S. Patent No. 5,597,560), already of record, for the reasons of record as set forth in the previous Office action as applied to claims 16, 29, 31-34, 37-41 and 45-53.

Applicant's amendments and arguments have been carefully considered, but fail to persuade the Examiner of error in his determination of obviousness.

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In the present claims which recite that the formulation is not intended for topical administration such is not seen to distinguish over the composition of Bergamini et al. as such recitations are no more than statements of intended use and do not impart any further physical or otherwise material limitation to the claimed formulations that is not found in the prior art. The compositions are evaluated against the prior art compositions in terms of what they are rather than how they are intended to be used. Similar reasoning is applied to composition employed in the method of claims 42-44.

See MPEP 2111.02 "Preamble Statements Reciting Purpose or Intended Use" and the cases cited therein.

***Claim Objection***

Claims 3-15, 17-28, 30, 35 and 36 are objected to as depending from a rejected base claim, but are otherwise in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ray Henley whose telephone number is 703-308-4652. The examiner can normally be reached on M-F, 8:30 am to 4:00 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on 703-308-4725. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
Raymond J. Henley III

**RAYMOND HENLEY, III  
PRIMARY EXAMINER  
GROUP 1200**